

**REMARKS**

This Request for Continued Examination (RCE) and Response is submitted in response to the final Office Action mailed on August 6, 2008 (the "Office Action") in connection with the above-referenced application. Applicant notes with appreciation that the art-based rejections set forth in the previous Office Action have been withdrawn. However, new grounds of rejection have now been advanced. Reconsideration and allowance of the application is requested in view of the amendments and remarks presented herein.

In the outstanding Office Action, the following issues were raised:

- Claims 1-24 were rejected under 35 USC §112, second paragraph, as being indefinite for purportedly failing to particularly point out and distinctly claim the subject matter of the invention.
- Claims 1-24 were rejected under 35 USC §103(a) based on US Patent Publication No. 2002/0059054 to Bade et al et al. ("Bade") in view of U.S. Patent No. 6,507,824 to Yon et al. ("Yon") or vice versa.
- Claim 21 was rejected (2<sup>nd</sup> time) under 35 USC §103(a) based on Bade/Yon in further view of US Patent No. 6,342,952 to Chan ("Chan").

The present Response is intended to be fully responsive to the rejections raised in the Office Action. In view of the amendments and arguments advanced herein, Applicant submits that the issues outlined above are fully addressed and remedied. Thus, Applicant believes that each of the claims now pending in the application is in condition for allowance. Applicant does not acquiesce to any portion of the Office Action not particularly addressed herein.

# **1. Finality of the Office Action**

Applicant notes with appreciation that the Examiner has considered Applicant's arguments and withdrawn all previous art-based rejections. The Examiner, however, has raised new grounds for rejection based on newly cited Bade. Pursuant to MPEP 706.07(a), the Examiner has made the current Office Action final, stating that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action." Applicant respectfully suggests that the Examiner has erred in his assessment of finality. More particularly, Applicant submits that each of the amendments advanced in the previous Response was for the sake of clarity in view of rejections under 35 USC §112, second paragraph. Applicant further notes that none of the amendments was advanced to distinguish Applicant's invention over the cited prior art. Accordingly, Applicant submits that the new ground(s) of rejection was/were necessitated based on Applicant's arguments alone.

Indeed with regards to Yon, Applicant argued that "the Yon patent fails to teach or suggest a system that includes, *inter alia*, at least the following specific claim recitations:"

With regards to claim 1:

"a processor associated with said server and in communication with said storage medium and with programming that operates with said processor:

- i) to monitor communications to said server from said plurality of client workstations related to said e-palette; and
- ii) to automatically communicate the existence of a communication related to said e-palette from one of said plurality of client workstations to said specifier workstation."

With regards to claim 15:

“a system/method whereby a specifier -- using server functionality -- may automatically communicate the existence/availability of an e-palette at the server to a predetermined set of suppliers.

Finally with regards to claim 22:

“a storage medium/server architecture that function to capture e-palette information received from the specifier...at least one responsive submission communicated by a supplier so as to facilitate color-related commerce...[and] an e-palette with a set of goods”

With regards to Chan, Applicant argued that “the Chan patent suffers from the same deficiencies as discussed above with reference to the Yon patent.” Applicant proceeded to distinguish Chan using the same specific claim limitations cited above with respect to Yon.

Applicant notes that *none* of the distinguishing claim limitations (cited with respect to Yon and Chan) were advanced as amendments to the claims. Moreover, the Bade reference was cited to allegedly disclose a server-based architecture and was admitted not to disclose “the features of the information in the order/quote received,” i.e., “specified color data spectra”, “e-palette information” or “information associated with the specified e-palette.” Applicant notes that the amendments advanced in the previous Response involve, *exclusively*, such features of information.

Thus, applicant respectfully traverses the Examiner’s determination of finality and requests reconsideration thereof. In the event the Examiner’s reconsideration leads to a determination that the current Office Action should not have been a “final rejection,” applicant respectfully requests that the Patent Office records be so corrected and that the RCE fee authorized herein be refunded to applicant’s undersigned counsel’s Deposit Account.

**2. Claim Amendments**

Applicant has canceled each of independent claims 1 (system), 15 (method) and 22 (system). Applicant has advanced new independent claims 25 (system) and 26 (method). Applicant has also canceled each of dependent claims 2, 5, 10-11, 17-18 and 23-24, without prejudice. Applicant has advanced new dependent claims 27 and 28. Applicant further notes that each of dependent claims 3-4, 6-9, 12-14, 16, 19, and 21 have been amended to depend from one of claims 25 or 26. The terminology of claims 3-4, 6-9, 12-14, 16, 19, and 21 was also amended to coincide with that of claims 25 and 26. Support for each of the new claims and for the amendments to the dependent claims can be found throughout the specification, as filed. Prompt entry all changes is respectfully requested.

**3. Rejections of Claims 1-24 under 35 USC §112, Second Paragraph**

As noted above, claims 1-24 were rejected under 35 USC §112, second paragraph, as being indefinite for purportedly failing to particularly point out and distinctly claim the subject matter of the invention. In view of the canceling of claims 1-2, 5, 10-11, 15, 17-18 and 22-24 and the amendments to claims 3-4, 6-9, 12-14, 16, 19, and 21, reconsideration and withdrawal of the foregoing Section 112 rejections are respectfully requested. More particularly, Applicant submits that each of the rejections under 35 USC §112, second paragraph, is moot since the disputed language has been one of canceled or deleted in each instance. Applicant further respectfully submits that all currently pending claims are in full compliance with 35 USC §112.

**4. Rejections of Claims 1-24 under 35 USC §103(a)**

As noted above, claims 1-24 were rejected under 35 USC §103(a) based on Bade in view of Yon or vice versa. Claim 21 was also rejected under 35 USC §103(a) based on Bade/Yon in further view of US Patent No. 6,342,952 to Chan ("Chan"). (Applicant notes that Chan was relied upon by the Examiner for the sole purpose of teaching the inclusion of "color measuring equipment;" page 11 of the Office Action).

As previously discussed, Applicant has cancelled each of independent claims 1, 15 and 22 and replaced them with new independent claims 25 and 26. Accordingly, Applicant will address the standing obviousness rejections in view of new independent claims 25 and 26. Applicant respectfully submits that each of independent claims 25 and 26 patentably distinguishes over the proposed combination of Bade and Yon. Moreover, each of the remaining dependent claims (claims 3-4, 6-9, 12-14, 16, 19, 21) patentably distinguishes over Bade/Yon for at least the same reasons noted with respect the corresponding independent claim. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all standing obviousness rejections based on the proposed combination of Bade and Yon.

Applicant respectfully submits that a *prima facie* case for obviousness under 35 U.S.C. §103 cannot be supported with respect to independent claims 25 and 26. As is well known, the factual inquiries for evaluating "obviousness" under 35 U.S.C. §103 are set forth in Graham v. John Deere Co., 383 U.S. 1 (1966). These factors require that the Examiner: (1) determine the scope and content of the prior art, (2) ascertain the differences between the prior art and the claims-at-issue, (3) resolve the level of ordinary skill in the pertinent art, and (4) consider objective evidence present in the application (if any) indicating obviousness or nonobviousness. The following passage from the MPEP sets forth the Examiner's burden in this regard.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. ... The initial evaluation of *prima facie* obviousness ... relieves both the examiner and the applicant from evaluating evidence beyond the prior art and the evidence in the specification until the art has been shown to suggest the claimed invention. ... To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences", conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon the applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, *impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.* MPEP, §2142 (emphasis added).

The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007). Moreover, where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. In re Young, 927 F.2d 588 (Fed. Cir. 1991). MPEP §2143.01 also notes that both (1) "a proposed modification [that] would render the prior art invention being modified unsatisfactory for its intended purpose" and (2) "a proposed modification or combination of the prior art [that] would change the principle of operation of the prior art invention being modified" would therefore

render insufficient a prima facie claim of obvious. See also In re Gordon, 733 F.2d 900 (Fed. Cir. 1984) and In re Ratti, 270 F.2d 810 (CCPA 1959).

Applicant respectfully submits that each of independent claims 25 and 26 patentably distinguishes over the proposed combination of Bade and Yon, at least because the claims include substantial and patentable differences relative to the teachings of the prior art references, whether taken alone or in combination. The tertiary reference -- Chan -- fails to cure the fundamental deficiencies of the proposed Bade/Yon combination. Applicant further submits that the application of a general network-based bidding system (Bade) to the highly specific color-based system/method of the subject application represents impermissible hindsight and, in fact, conflicts with the teachings of Bade.

**Differences over the Prior Art:**

Applicant respectfully submits that independent claims 25 and 26 includes numerous limitations not found in nor taught/suggested by Bade/Yon and that, therefore, each of independent claims 25 and 26 patentably distinguishes over Bade/Yon. The following distinguishing limitation are noted in particular:

- I. **“means for predefining a plurality of specifier shades, a plurality of specifier substrates and a plurality of suppliers” (claim 25); “using one of the specifier workstations to predefine a plurality of specifier shades, a plurality of specifier substrates and a plurality of suppliers” (claim 26).**

Applicant notes that the Examiner has equated informational components of an e-palette submission (shades, substrates, suppliers, etc.) with IP components of a virtual embedded system disclosed in Bade (see Page 6 of the Office Action; re: “information associated with the project/design”). Applicant submits that Bade fails to disclose, *inter alia*, specifier means for predefining and storing such informational components in a database. More particularly, the subject application offers particular advantages over the prior art in that a specifier may create a

unique and expressive database of predefined information components from which e-palette submissions may quickly and easily be created (i.e., by selecting the desired informational components from the personalized database). The utility of predefining components is particular to color-specific applications in that color selection for a product is an exercise of subjective expression rather than objective design.

In Bade, conversely, the integrated design environment (IDE) includes a library of "IP components from different sources." See paragraph [0114]. "[A] user may select IP components of interest that they may add or in the case of hardware models modify for their own design." A user does not, however, *predefine* (i.e., before design) a database of creatively inspired unique IP components. Indeed, efficiency mandates that the IP components match industry available parts wherein standardization is the key.

**II. "means for creating a nested e-palette for a set of goods" (claim 25); "using the one of the specifier workstations to create a nested e-palette for a set of goods" (claim 26)**

Applicant notes that the Examiner has acknowledged that Bade fails to disclose any color specific limitations, e.g., the creation of a nested e-palette (see Page 7 of the Office Action). Applicant submits that Yon, similarly, fails to disclose a *nested e-palette* as embodied in the claims and defined in the specification. More particularly, the present application discloses a nested e-palette created by (1) selecting one or more substrates (e.g., cotton, nylon, leather, etc.) to associate with a set of goods (e.g., a fall clothing line) and (2) selecting one or more shades to associate with each substrate. Each selected substrate and shade defines a nesting within the nested e-palette.

As noted in the previous Response, Yon fails to teach or suggest associating an e-palette with a set of goods (note that the selection of a product 32 in Fig. 2 refers to the selection of a color product, e.g. paint, cycolac, etc., rather than a product for coloring; see, e.g., Fig. 5).



Indeed, the alleged “e-palette” equivalent in Yon is essentially an order form for a color product irrespective of its end use. Applicant further submits that Yon fails to disclose or suggest, *inter alia*, the selection of one or more substrates, and the association of one or more shades with each substrate. Thus, the spectral data in Yon is representative of the color product prior to application to a substrate.

Conversely, the subject application, discloses a system advantageously suited for, *inter alia*, product-line management. Indeed, the creation of a nested e-palette enables a specifier to design and track color and substrate characteristics for a given product line. Furthermore, the nested structure of the nested e-palette allows the specifier to tie together a product line using common elements; e.g., a product-line may feature a plurality of products each manufactured from one or more common substrates, wherein the shades for the substrates are drawn from a common color palette (hence the term “e-palette”). Since each substrate is associated with one or more shades, the spectral data defining each shade is representative of a desired final color of the substrate (post-application) rather than an original color of a color product (pre-application).

### **III. “means for filtering the one or more uploaded nested e-palettes” (claim 25)**

Applicant notes that the recited “means of filtration” “permits [a] supplier to focus on palette submissions using desired criteria” (page 23 of the specification). Thus, a supplier may, e.g., focus on all nestings for a given color/substrate combination. This filtering ability advantageously enables a supplier to simultaneously prepare submission data for a plurality nestings and/or nested e-palettes even wherein the e-palettes are uploaded by different specifiers. The system disclosed in Bade does not include nor suggest this functionality. More particularly, since virtual embedded systems do not by nature contain a common groupings of components, each invitation to bid must be viewed and addressed separately.

The tertiary reference -- Chan -- fails to cure the deficiencies discussed above, whether taken alone or in combination with Bade and/or Yon.

For at least the foregoing reasons, applicant submits that all pending claims patentably distinguish over the proposed combination of Bade and Yon, as well as the proposed combination of Bade/Yon/Chan. Reconsideration and withdrawal of the outstanding obviousness rejections is respectfully requested.

**The Proposed Combination of Base and Yon (and Chan) Represents Impermissible Hindsight:**

Applicant respectfully submits that the sole rationale for combining Bade and Yon (whether with or without Chan) in the manner proposed by the Examiner is Applicant's disclosure and -- by extension -- the claims-at-issue. To arrive at the combination relied upon in rejecting the claims-at-issue, it is necessary to ignore core teachings of the cited references, wherein the only basis for doing so is Applicant's disclosure/claims.

As previously discussed, the Bade reference discloses an integrated design environment for designing and testing virtual embedded system using simulated IP components. Thus, Bade discloses a virtual test board which emulates a real design environment. The signals and systems world of electronic design easily lends itself to a computer-based simulation. Color emulation, however, is far more difficult to achieve. Elements such as texture, shading, luster, etc., are not easily embodied in the virtual world. Similarly, the interplay between colors and substrates cannot be theoretically tested in a virtual color lab. Applicant's invention is unique because it seamlessly combines a traditional physical color lab with the advantages of e-palettes. Bade teaches away from combining physical and virtual testing environments. More particularly, the integrated design environment disclosed in Bade is specifically calculated to *eliminate* the need

for physical testing. See paragraph [0021]. Therefore, Bade would discourage one skilled in the art from incorporating physical testing elements into specifier/supplier communication system.

Applicant also notes that the subject matter of Bade is so remote from that of Yon that one of ordinary skill in the art would not have thought to combine the references absent the present disclosure. More particularly, Bade discloses a general network-based bidding system (“a web-based service [that] may be used to invite sellers to provide a quote for a specific design, in a request-for-quote (RFQ scenario);” paragraph [0207]). Beyond this general concept, however, Bade discloses little with respect to the focus of the subject application. Indeed the request-for-quote and the bidding response in Bade differ extensively from the color-specific uploading of a nested e-palette and/or submission data presented in the subject application or the application-specific paint order forms of Yon. Thus, in contrast with the general system in Bade, the subject application discloses a narrowly tailored system for enabling a specifier to define, manage, and interrelate color/material attributes, e.g., for a product-line (using the novel construct of a nested e-palette); even the process by which suppliers respond to uploaded e-palettes is application-specific, involving, *inter alia*, physically testing color samples and matching spectral data.

Applicant notes that there are conceptual differences, as well, between generating a color palette for a product line and designing an embedded virtual system. More particularly, a product-line is often designed to include a number of different embodiments, e.g., for color variety. A virtual system of IP components, on the other hand, is designed with a focus on efficiency and optimal performance. Since the IP components in Bade serve practical rather than aesthetic purposes, the design process is linear rather than tangential. Thus, conceptually it

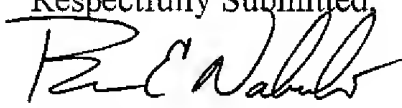
would have been difficult to adapt a linear design system to fit an application requiring parallel design.

As noted above, the differences between the generalized bidding board in Bade and the specific color-based applications in Yon are vast and unbridgeable absent the present disclosure. The tertiary reference -- Chan -- fails to offer any bridging teachings. Applicant therefore submits that the outstanding obviousness rejections based on the proposed combination of Bade and Yon represents impermissible hindsight on the part of the examiner, and should be withdrawn. Prompt action consistent therewith is respectfully requested.

### CONCLUSION

Applicant respectfully submits that all pending claims are now in condition for allowance. Prompt action leading to an early Notice to that effect is earnestly solicited. If the Examiner believes that personal communication will expedite the prosecution, the Examiner is respectfully requested to contact the undersigned at the number listed below.

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Respectfully Submitted,  
  
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